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09/870,266	05/29/2001	Christopher M. White	3382-56619-01	8058
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EXAMINER				
SCHNURR, JOHN R				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/870,266

Applicant(s)

WHITE ET AL.

Examiner

JOHN R. SCHNURR

Art Unit

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Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-7 and 13-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-7 and 13-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/02)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date 12/21/2007.

DETAILED ACTION

1. This Office Action is in response to the Amendment After Non-Final Rejection filed 02/01/2008. Claims 4-7 and 13-26 are pending and have been examined.
2. The information disclosure statement (IDS) submitted on 12/21/2007 was considered by the examiner.

Response to Arguments

3. Applicant's arguments with respect to claims 4-7 and 13-22 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's argument (Remarks page 8 paragraph 3 to page 9 paragraph 3) that Herz (US 6,144,376) does not teach the claim 13 feature of "automatically cycling", the examiner respectfully disagrees. Herz teaches creating virtual channels of programming desirable to the viewer. When the viewer selects one of these virtual channels the calculated most desirable program is presented to the viewer. After the program ends the next desirable program is presented to the viewer, thus the system automatically cycles through plural selections.

The examiner notes that the previous office action failed to provide rejections for claims 22-26. The examiner apologizes for this oversight and has supplied proper rejections for each of the claims 22-26 in this office action.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 13-19, 22 and 23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 13-19, 22 and 23 are drawn to functional descriptive material recorded on a machine readable-medium. Normally, the claim would be statutory. However, the specification at page 3 line 16 to page 4 line 9 defines the claimed readable medium as encompassing non-statutory subject matter such as "control data can be transmitted using a conventional protocol (e.g. TCP/IP) and modulated onto a suitable carrier frequency for distribution over the network".

A "signal" embodying functional descriptive material is neither a process nor a product (i.e., a tangible "thing") and therefore does not fall within one of the four statutory classes of § 101. Rather, "signal" is a form of energy, in the absence of any physical structure or tangible material.

Because the full scope of the claim as properly read in light of the disclosure encompasses non-statutory subject matter, the claim as a whole is non-statutory.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claim 13, 4 and 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (US 5,758,257) in view of Alexander (US 6,177,931) and further in view of Connely (US 6,144,376).

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Considering claim 13, Herz discloses a method of operating a computer implemented interactive entertainment system (column 47, lines 26-29) comprising: logging entertainment selections of plural users (column 41, lines 26-27 and 33-36); generating affinity groupings based on similarities in the movie selections logged (column 48, line 19) and tv selection logged (column 6, lines 50-60, column 15, lines 22-29 and column 38, lines 56-64); logging entertainment selections of a first user to create a first user profile (column 9, lines 30-51 and column 45, lines 59-63) the entertainment selections comprising at least one television program watched and at least one video on demand movie received (column 48, lines 55-65); determining an affinity grouping similar to the first user's first user profile (column 34, lines 31-32); and presenting the first user a listing of available programs favored by members of the determined affinity grouping (column 47, lines 38-42). Herz further discloses that upon returning to an interactive entertainment channel, the system automatically cycles through plural selections in the determined affinity grouping (column 22 line 64 to column 23 line 7).

Herz fails to disclose plural viewing channels; on certain of said channels, receiving television programs for viewing; on at least one of said channels, receiving video on demand movies.

In analogous art, Alexander discloses plural viewing channels (column 15, lines 47-48); on certain of said channels, receiving television programs for viewing (column 30, lines 55-58); on at least one of said channels, receiving video on demand movies (column 21, lines 50-54 and column 22, lines 29-33).

It would have been obvious to one of ordinary skill in the art to modify the combined system of Herz and Yoshinobu to include presenting said copied video programs for viewing, as taught by Alexander, for the benefit of minimizing channel surfing.

Herz and Alexander fail to disclose receiving HTML-based content on at least one of said channels comprising at least one of a game channel, an interactive news channel, or a jukebox channel.

In analogous art, Connely discloses HTML-based content on at least one of said channels comprising a game channel (see channel 9 in figure 5C).

It would have been obvious to one of ordinary skill in the art to modify the combined system of Herz and Alexander to include HTML-based content on at least one of said channels comprising a game channel, as taught by Connely, for the benefit of providing the user web based entertainment via a television user interface.

Considering claim 4, it is rejected for the same reasons as discussed in claim 13.

As for claim 5, it is met by the combination of Herz, Connely, and Alexander. In particular, Alexander discloses listing the copied video program in an electronic

program guide associated with the system, together with a viewing channel on which the copied video can be viewed (Alexander—column 30, lines 53-58).

7. Claims 6, 20 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (US 5,758,257) in view of Yoshinobu (US 5,734,444) further in view of Alexander (US 6,177,931) and further in view of Smith (US 5,933,141).

Considering claim 6, Herz discloses a method of operating a video system (412—figure 4), the system including a video input (column 40, line 66 – column 41, line 4), a controller (column 45, lines 45-46), a remote control (Fig. 10 1008), a screen (Fig. 10 TV) and a store (902—figure 9), the method comprising: monitoring a user's viewing habits to determine a favorite broadcast video program (column 14, lines 5-7 and column 42, lines 6-8). Herz further discloses generating profiles for plural users, said profiles comprising user viewing habits (column 25, lines 7-13) and other user habits comprising a game habit (column 47, lines 22-26) and customer's zip code (column 11, lines 61-66); presenting a listing of available programs that appeared favored by other viewers with profiles similar to the user's viewing habits (column 5, lines 23-52 and column 46, lines 50-57); wherein the system can suggest to a viewer other programs based on similar viewers' preferences (column 22, line 64 – column 23, line 5).

Herz fails to disclose copying the video program to the store if the user is not viewing said program when broadcast. Herz also fails to disclose that the user need

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not plan in advance to record a favorite program, because the favorite program is automatically recorded if it is not viewed by the user when broadcast. Furthermore, Herz fails to disclose monitoring the user's viewing habits to determine a ranking of viewed broadcast video programs by viewing frequency; and copying to the store plural programs that are not viewed by the user when broadcast, in accordance with said ranking.

In analogous art, Yoshinobu discloses copying the video program to the store if the user is not viewing said program when broadcast. Yoshinobu also discloses that the user need not plan in advance to record a favorite program, because the favorite program is automatically recorded if it is not viewed by the user when broadcast (column 24, lines 51-59). Furthermore, Yoshinobu also discloses monitoring the user's viewing habits to determine a ranking of viewed broadcast video programs by viewing frequency; and copying to the store plural programs that are not viewed by the user when broadcast, in accordance with said ranking (column 11 line 64 to column 12 line 14 and column 15 lines 38-47 and column 24 lines 51-59). Therefore, the recording of programs is in accordance with said ranking.

It would have been obvious to one of ordinary skill in the art to modify Herz's system to include an automatic recording of the favorite program as well as the recording of programs in accordance with a ranking system, as taught by Yoshinobu, for the benefit of not missing a favorite program when broadcast while watching another favorite program and also for accommodating the user's viewing preference of recorded programs.

Herz and Yoshinobu fail to disclose defining plural viewing channels; on certain of said channels, presenting television programs for viewing; on at least one of said channels, presenting said copied video program for viewing. Herz and Yoshinobu further fail to disclose maintaining the copied video programs are after viewing.

In analogous art, Alexander discloses defining plural viewing channels (column 15, lines 47-48); on certain of said channels, presenting television programs for viewing (column 30, lines 55-58); on at least one of said channels, presenting said copied video program for viewing (column 21, lines 50-54 and column 22, lines 29-33). Alexander further discloses that the copied video programs are maintained after viewing (the recorded programs may be set to be viewed once, daily, or weekly i.e. the program is maintained after the first viewing for the daily or the weekly viewing—column 21, lines 50-54 and column 12, lines 10-21, where Alexander explicitly discloses copying video programs on a Digital Video Disc (DVD), wherein the copied video programs are obviously maintained after viewing). Alexander further discloses displaying a translucent menu in response to receiving an indication that a remote control button has been pressed and highlighting a region of the menu (column 3 lines 21-55).

It would have been obvious to one of ordinary skill in the art to modify the combined system of Herz and Yoshinobu to include presenting said copied video programs for viewing, as taught by Alexander, for the benefit of minimizing channel surfing.

However, Alexander fails to disclose the menu is a control menu with a play button and minimizing the control panel when the play button is selected.

In an analogous art, Smith discloses displaying a control panel with a play button and minimizing the panel when the play button is selected (Figs. 4A-4C column 6 line 51 to column 7 line 25).

It would have been obvious to one of ordinary skill in the art to modify the combined system of Herz, Yoshinobu and Alexander to include a control panel with a play button and minimizing the panel when the play button is selected, as taught by Smith, for the benefit of preventing the display screen from becoming cluttered (see column 1 lines 49-63 Smith).

With regards to claim 20, it is met by the combination of Herz, Yoshinobu, and Alexander. In particular, Herz discloses that the specific program is suggested to the viewer (column 22, line 64 – column 23, line 5 and column 47, lines 37-45) in response to a viewer's inquiry (column 47, lines 37-45 and column 48, line 48 – column 49, line 1).

Regarding claim 21, it is met by the combination of Herz, Yoshinobu, and Alexander. In particular, Herz discloses that the specific program is suggested to the viewer (column 22, line 64 – column 23, line 5 and column 47, lines 37-45) autonomously (column 49, lines 52-54).

8. Claims 7 and 14-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (US 5,758,257) and Yoshinobu (US 5,734,444) in view of Alexander (US

6,177,931) further in view of Smith (US 5,933,141) and further in view of Lazarus (US 5,652,613).

Regarding claim 7, Herz discloses a method of operating a video system (412—figure 4), the system including a video input (column 40, line 66 – column 41, line 4), a controller (column 45, lines 45-46), a remote control (Fig. 10 1008), a screen (Fig. 10 TV) and a store (902—figure 9), the method comprising: monitoring a user's viewing habits to determine a favorite broadcast video program (column 14, lines 5-7 and column 42, lines 6-8).

Herz fails to disclose copying the video program to the store if the user is not viewing said program when broadcast. Herz also fails to disclose that the user need not plan in advance to record a favorite program, because the favorite program is automatically recorded if it is not viewed by the user when broadcast. Furthermore, Herz fails to disclose monitoring the user's viewing habits to determine a ranking of viewed broadcast video programs by viewing frequency; and copying to the store plural programs that are not viewed by the user when broadcast, in accordance with said ranking.

In analogous art, Yoshinobu discloses copying the video program to the store if the user is not viewing said program when broadcast. Yoshinobu also discloses that the user need not plan in advance to record a favorite program, because the favorite program is automatically recorded if it is not viewed by the user when broadcast (column 24, lines 51-59). Furthermore, Yoshinobu also discloses monitoring the user's

viewing habits to determine a ranking of viewed broadcast video programs by viewing frequency; and copying to the store plural programs that are not viewed by the user when broadcast, in accordance with said ranking (column 11 line 64 to column 12 line 14 and column 15 lines 38-47 and column 24 lines 51-59). Therefore, the recording of programs is in accordance with said ranking.

It would have been obvious to one of ordinary skill in the art to modify Herz's system to include an automatic recording of the favorite program as well as the recording of programs in accordance with a ranking system, as taught by Yoshinobu, for the benefit of not missing a favorite program when broadcast while watching another favorite program and also for accommodating the user's viewing preference of recorded programs.

Herz and Yoshinobu disclose defining plural viewing channels (virtual channels); on certain of said channels, presenting television programs for viewing (television programs are presented on said virtual channels—Herz—column 47, lines 38-52); presenting the most desirable video program on a designated channel (a virtual channel) customized for the customer (Herz—column 47, lines 38-42). Herz and Yoshinobu further disclose that the user need not plan in advance to record a favorite program, because the favorite program is automatically recorded if it is not viewed by the user when broadcast (Yoshinobu— column 24, lines 51-59).

Herz and Yoshinobu fail to disclose presenting said *copied* video program for viewing on a designated channel.

In analogous art, Alexander discloses defining plural viewing channels (column 15, lines 47-48); on certain of said channels, presenting television programs for viewing (column 30, lines 55-58); on at least one of said channels, presenting said copied video program for viewing (column 21, lines 50-54 and column 22, lines 29-33). Alexander further discloses displaying a translucent menu in response to receiving an indication that a remote control button has been pressed and highlighting a region of the menu (column 3 lines 21-55).

It would have been obvious to one of ordinary skill in the art to modify the combined system of Herz and Yoshinobu to include presenting said copied video programs for viewing, as taught by Alexander, for the benefit of minimizing channel surfing.

However, Alexander fails to disclose the menu is a control menu with a play button and minimizing the control panel when the play button is selected.

In an analogous art, Smith discloses displaying a control panel with a play button and the panel becoming more transparent when the play button is selected (Figs. 4A-4C column 6 line 51 to column 7 line 25).

It would have been obvious to one of ordinary skill in the art to modify the combined system of Herz, Yoshinobu and Alexander to include a control panel with a play button and minimizing the panel when the play button is selected, as taught by Smith, for the benefit of preventing the display screen from becoming cluttered (see column 1 lines 49-63 Smith).

Herz, Yoshinobu Alexander and Smith fail to disclose that as space is needed in the video system, said copied video programs are overwritten in the following priority, first overwrite viewed copied video programs, then overwrite non-viewed copied video programs.

In analogous art, Lazarus discloses overwriting viewed copied video programs, then overwrite non-viewed copied video programs (column 2, lines 56-64, column 5, lines 22-26 and column 4, lines 21-29).

It would have been obvious to one of ordinary skill in the art to modify the combined system of Herz, Yoshinobu, and Alexander to include a prioritized overwriting method, as taught by Lazarus, for the benefit of freeing storage space when the capacity is reached.

Considering claim 14, it is met by the combination of it is met by the combination of Herz, Yoshinobu, Alexander, Smith and Lazarus. In particular, Herz discloses a corresponding computer readable medium (figure 11 and column 10, lines 6-20 and column 49, lines 32-51) for performing the method of claim 7. Yoshinobu discloses listing the automatically copied favorite video program in the favorite channel by title (column 24, lines 21-26) and length (start time and end time—column 14, lines 48-50) and automatically playing the copied favorite video program when the favorites channel is selected (column 14, lines 54-57).

As for claim 15, it is rejected for the same reasons as discussed in claims 5, 7, and 14.

With regards to claim 16, it is met by the combination of it is met by the combination of Herz, Yoshinobu, Alexander, and Lazarus. In particular, Yoshinobu discloses listing the automatically copied favorite video program in the favorite channel by title (column 24, lines 21-26) and length (start time and end time—column 14, lines 48-50).

Regarding claim 17, it is met by the combination of it is met by the combination of Herz, Yoshinobu, Alexander, and Lazarus. In particular, Yoshinobu discloses automatically playing the copied favorite video program when the favorites channel is selected (column 14, lines 54-57).

Considering claim 18, it is met by the combination of it is met by the combination of Herz, Yoshinobu, Alexander, and Lazarus. In particular, Yoshinobu discloses listing plural copied video programs (Yoshinobu—see figure 10) from which the copied favorite video program can be selected for playback (column 14, lines 48-57).

9. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (US 5,758,257), Yoshinobu (US 5,734,444), and Alexander (US 6,177,931), in view of

Smith (US 5,933,141) in view of Lazarus (US 5,652,613), as applied to claim 14 above, and further in view of Daniels (2002/0032907).

As for claim 19, Herz, Yoshinobu, Alexander, Smith and Lazarus fail to disclose permitting a viewer to take a break from broadcast programming comprising instructions for receiving a delay program selection; and instructions for routing broadcast programming to memory upon receiving the delay program selection.

In analogous art, Daniels discloses permitting a viewer to take a break from broadcast programming (paragraph 0080, lines 8-11) comprising instructions for receiving a delay program selection (pause command from the viewer—paragraph 0080, lines 1-4); and instructions for routing broadcast programming to memory upon receiving the delay program selection (start-recording upon receiving the pause command—paragraph 0021, lines 8-10 and paragraph 0083, lines 1-8).

It would have been obvious to one of ordinary skill in the art to modify the combined system of Herz, Yoshinobu, Alexander, Smith and Lazarus to include permitting a viewer to take a break from broadcast programming by use of a delay command, as taught by Daniels, for the benefit of allowing the viewer to take a break from viewing the current channel and/or switch to another channel (paragraph 0080, lines 8-11).

10. Claims 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (US 5,758,257) in view of Yoshinobu (US 5,734,444) further in view of Alexander

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(US 6,177,931) further in view of Smith (US 5,933,141) and further in view of Okada (US 7,095,949).

As for claims 24-26, Herz, Yoshinobu, Alexander and Smith fail to disclose deleting at least one of the plural programs copied to the store by time of copy, wherein the oldest copy is deleted.

In analogous art, Okada discloses deleting stored video content by time of copy, wherein the oldest copy is deleted (column 8 lines 45-47).

It would have been obvious to one of ordinary skill in the art to modify the combined system of Herz, Yoshinobu, Alexander and Smith to include deleting stored video content by time of copy, wherein the oldest copy is deleted, as taught by Okada, for the benefit of allowing the newest programming to be recorded.

11. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Herz (US 5,758,257) and Yoshinobu (US 5,734,444) in view of Alexander (US 6,177,931) further in view of Smith (US 5,933,141) further in view of Lazarus (US 5,652,613) and further in view of Okada (US 7,095,949).

As for claims 22 and 23, Herz, Yoshinobu, Alexander, Smith and Lazarus fail to disclose deleting at least one of the plural programs copied to the store by time of copy, wherein the oldest copy is deleted.

In analogous art, Okada discloses deleting stored video content by time of copy, wherein the oldest copy is deleted (column 8 lines 45-47).

It would have been obvious to one of ordinary skill in the art to modify the combined system of Herz, Yoshinobu, Alexander, Smith and Lazarus to include deleting stored video content by time of copy, wherein the oldest copy is deleted, as taught by Okada, for the benefit of allowing the newest programming to be recorded.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN R. SCHNURR whose telephone number is (571)270-1458. The examiner can normally be reached on Monday - Friday, 8:00am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on (571) 272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JRS

/Christopher Grant/
Supervisory Patent Examiner, Art Unit 2623